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WILLIAM C GERSTENZANG
NORRIS MCLAUGHLIN & MARCUS PA
220 EAST 42ND STREET
30TH FLOOR
NEW YORK, NY 10017

EXAMINER

FERGUSON, LAWRENCE D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/431,849
Filing Date: November 02, 1999
Appellant(s): NICKEL, OILVER

Howard C. Lee
For Appellant

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JUN 03 2003
GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3-20-03.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 2-9 and 12 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

5385783	PATEL et al.	01-1995
5683806	SAKUMOTO et al	11-1997
5935669	LEEUEWENBURGH	08-1999

Claim Rejections – 35 USC 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. (US 5,385,783) in view of Sakumoto et al. (US 5,683,806) further in view of Leeuwenburgh (U.S. 5,935,669).

Patel discloses a high temperature resistant masking tape comprising a paper substrate, a release coat on one surface of said paper, and an adhesive on the other surface of said paper (abstract; col. 2, lines 1-5) comprising a maximum heat resistance of 165°C (specification, col. 1, line 23) and a tape comprised of conventional crepe paper (specification, col. 1, lines 59-60). The reference discloses a tape that is rolled up on a core (specification, col. 1, line 42). Patel does not disclose a film. While Patel does not disclose a specific width or thickness for the adhesive tape, he does state that the tape can be prepared into predetermined widths and lengths. Patel does not disclose that the masking film is folded or a polyolefin film.

Sakumoto teaches an adhesive tape comprising a heat resistant base film and a protective adhesive layer laminated on at least one surface of said base film (abstract, col. 2, lines 1-3). This protective laminated adhesive layer can be made out of

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polyolefin, such as polyphenylene (specification, col. 1, line 21). Sakumoto teaches that the protective layer has a thickness of from 1 to 200 μ m (specification, col. 2, line 54-55).

Patel and Sakumoto are analogous art because they are from the same field of endeavor, that is masking tape. At the time of the invention, it is obvious to a person of ordinary skill in the art to combine the protective laminated adhesive layer of Sakumoto with the adhesive layer of Patel in order to provide protection for the adhesive layer of Patel so it would not lose its bonding properties. Neither reference teaches the masking film being folded or the masking film extending beyond said second edge of the masking paper.

Leeuwenburgh teaches a cover sheet folded with extending folds protruding beyond the other folding layers, an adhesive tape being fastened along the longitudinal edge portion (abstract) where the folded material is rolled (column 1, lines 64-65). Although Leeuwenburgh does not explicitly teach his cover sheet is a masking strip, it comprises the same materials and has the same function as applicants claimed masking strip, absent any evidence to the contrary. All the references are analogous art because they are from the same field of adhesive tapes. It would have been obvious to one of ordinary skill in the art to fold the masking strip of Patel leaving extended portions because Leeuwenberg teaches this is a conventional practice within the art and the extended portion can be used to adhere the strip to various surfaces.

RESPONSE TO ARGUMENTS**Issue 1**

Appellant maintains that claims 2-9 and 12 are not unpatentable over Patel et al. (US 5,385,783) in view of Sakumoto et al. (US 5,683,806) further in view of Leeuwenburgh (U.S. 5,935,669). Appellant argues, after practicing the fact-based inquiry set forth by *Graham v. John Deere Co.*, Examiner determined the Patel reference differed from Appellants' invention in at least four different ways. Examiner agrees that the single reference (Patel) does not disclose every aspect of the instantly claimed invention; however, the rejection has been rejected by Patel, Sakumoto and Leeuwenburgh. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant further argues even with the combination of Patel and Sakumoto, neither reference teaches the masking film being folded or the masking film extending beyond said second edge of the making paper. Examiner contends that although Patel nor Sakumoto teach this folding feature, Leeuwenburgh teaches the folding of films and adhesive layers is conventional and is not an improvement over the prior art. Further, the way the laminate is folded refers to intended use, which in this case does not add any patentable weight to the product. Appellant argues Patel does not teach or suggest the use of a masking paper/masking film on the contact adhesive layer. The use of the paper/film on the contact adhesive layer is of little consequence

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and is given little patentable weight in product claims. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136. Furthermore, Appellant continues to focus on the established deficiencies of the Patel et al. reference, where the rejections are based on combinations of references. Examiner reiterates that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Patel discloses a high temperature resistant masking tape comprising a paper substrate, a release coat on one surface of said paper, and an adhesive on the other surface of said paper (abstract; col. 2, lines 1-5) comprising a maximum heat resistance of 165°C (specification, col. 1, line 23) and a tape comprised of conventional crepe paper (specification, col. 1, lines 59-60). Patel is combined with Sakumoto, which teaches an adhesive tape comprising a heat resistant base film and a protective adhesive layer laminated on at least one surface of said base film (abstract, col. 2, lines 1-3). Appellant argues one of ordinary skill in the art would not be motivated to add this feature to the invention of Patel et al. because Patel's adhesive layer (64) is protected by the release coat (60) as the tape is rolled up. Examiner is not persuaded by this argument because the release coat of Patel and the film of Sakumoto represent the masking paper and masking film, as per instant claim 12.

Appellant disagrees with the characterization of the Sakumoto reference as analogous art because it is unclear that it is a masking tape. Sakumoto teaches an adhesive tape comprising a heat resistant base film and a protective adhesive layer laminated on at least one surface of said base film (abstract, col. 2, lines 1-3) which is directed to a masked tape. Appellant argues 'can be combined' is not the proper standard for establishing a prima facie case of obviousness. Examiner's reasons for combining the references do not have this basis. The references have been combined because Sakumoto teaches a protective covering that would be required on a tape so that it can be rolled up and not lose its adhesive properties. This is certainly known by one of ordinary skill in the art. It would have been obvious a person of ordinary skill in the art to combine the protective laminated adhesive layer of Sakumoto with the adhesive layer of Patel to provide protection for the adhesive layer of Patel so it would not lose its bonding properties. Appellant argues the Leeuwenburg reference does not establish a teaching as to why a folding pattern should be applied to the invention of Patel in view of Sakumoto. Leeuwenberg teaches folding masking tape is a conventional practice within the art and the extended portion can be used to adhere the tape to various surfaces. Leeuwenberg and Patel use the tapes for automobile painting and applying the tape to certain portions of the vehicle. Appellant uses his tape for the same purpose. Therefore the folding aspect of the instant invention certainly would be obvious to one of ordinary skill in the art. Appellant argues it is unclear whether the equivalence of the cover sheet of Leeuwenberg was to a masking paper, film or the entire strip. While Patel teaches rolling the entire tape, absent the masking film,

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Leeuwenberg further teaches rolling a masking tape along with a cover sheet (masking film). In response to applicant's argument that the references were picked and chosen from to construct a rejection, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Appellant argues Patel addresses the difference of width and length of the entire roll of tape and not the adhesive, masking paper and masking film. Patel discloses that width and lengths of the roll of tape are predetermined, which includes the various layers of the tape (i.e. adhesive and masking layers). Appellant argues there is lack of motivation for adding a masking film/paper between the release coat and adhesive layer of Patel as the release coat serves to protect the adhesive layer. Examiner is not persuaded by this argument because the release coat of Patel and the film of Sakumoto represent the masking paper and masking film, as per instant claim 12.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

LF

Lawrence Ferguson
May 31, 2003

Conferees

Cynthia Kelly

Paul Thibodeau

ckelly
pt

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

Cynthia Kelly

WILLIAM C GERSTENZANG
NORRIS MCLAUGHLIN & MARCUS PA
660 WHITE PLAINS ROAD
TARRYTOWN, NY 10591